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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,707	10/20/2003	Mitsuyoshi Tachimori	05225.0161-01	2843

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

LERNER, MARTIN

ART UNIT

PAPER NUMBER

2654

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/687,707	<b>Applicant(s)</b> TACHIMORI ET AL.	
	<b>Examiner</b> Martin Lerner	<b>Art Unit</b> 2654	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 to 3, 19, and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 3, 19, and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The limitations of "outputting the recognition result with the inquiry or without the inquiry based on a set status" and "if the recognition result does not represent a point on the map" are not supported by the originally filed Specification. Mainly, the Specification discloses a procedure to be followed if the recognition result is determined to be a point on a map. The Specification discloses a procedure when there is no position coordinate associated with the recognition result, but this is not the same as when the recognition result is not a point on a map. The Specification was reviewed, but does not clearly provide a written description for an embodiment of outputting based on a set status. The Specification does not provide a clear written description of the circumstances under which the recognition result is outputted with or without inquiry based on a set status.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 3, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Liu et al.* in view of *Brems et al.*

Applicants cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Regarding independent claims 1, 19, and 21, *Liu et al.* discloses a speech recognition method, apparatus, and computer readable instructions, comprising:

“a speech recognition unit configured to assign a recognition result to the user’s input speech” – a mobile navigation system includes an input device, which can be a speech recognition device (column 5, lines 64 to 66: Figure 7); a speech recognition device produces a recognition result for a user’s speech;

“a distance decision unit configured to calculate a distance between a point of the recognition result and a base point on the map if the recognition result represents a point on the map, and to decide whether the distance is above a threshold” – search manager 706 parses the request and obtains information pertaining to the request search; search manager 706 then obtains the position of the reference point for the

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current position ("a base point"); search manager then proceeds to look up the digital map and construct an initial list of points of interest ("a point of the recognition result") based on the distance constraint ("a threshold"), for example, within, say twenty miles from the current position (column 6, line 62 to column 7, line 17: Figure 9: Steps 902 to 908); the search manager follows to prune this list by the itinerary constraint; for example, the user wants no more than five miles of deviation from the routes defined in his current itinerary (column 7, lines 5 to 17: Figure 9: Steps 908 and 910); five miles from the current itinerary or twenty miles from the current position is "a threshold" for the distance.

Regarding independent claims 1, 19, and 21, *Liu et al.* discloses then sending the list of choices to the user interface manager, but omits "a response generation unit configured to generate an inquiry to confirm whether the recognition result is correct if the distance is above the threshold." However, it is quite common in speech recognition systems to ask the user to confirm a recognition result if there is a low degree of confidence in the result. In *Liu et al.*, a recognition result is uncertain if a distance of the recognition result from the current location is above a threshold. *Brems et al.* teaches a speech recognition system where a confidence in the interpretation is determined, and for an intermediate level of uncertainty, the user is asked to explicitly verify (or dis-verify) the result. (Column 6, Lines 11 to 44: Figure 5: Steps 411 and 413) *Brems et al.* suggests this procedure has advantages over forcing the user to re-enter information, and by mapping the confidence or "certainty level" of the results into several different action alternatives the consequences of making an error and the difficulty for the user

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responding to a verification request is considerably improved. (Column 2, Lines 23 to 32; Column 6, Lines 27 to 28) It would have been obvious to one of ordinary skill in the art to require a user to confirm whether a recognition result is correct if the distance is above a threshold in *Liu et al.* as suggested by *Brems et al.* for the purpose of improving the verification procedure.

Regarding claim 2, *Brems et al.* teaches the recognition interpretation is accepted without explicit verification if the interpretation has a high likelihood of being correct (column 6, lines 11 to 24: Figure 5: Steps 405 and 407); in *Liu et al.*, a high likelihood of being correct corresponds to "a distance not above the threshold."

Regarding claim 3, *Liu et al.* discloses requests besides search requests, e.g. a maneuver command ("does not represent a point on the map")(column 6, lines 30 to 61: Figure 8: Step 862); the user interface manager 704 also updates the user about the status of the mobile navigation system 14 and prompts the user for imminent maneuvers when the user's attention is needed (column 6, lines 13 to 16: Figure 8); a flowchart to identify commands must determine branching conditions, which implicitly involves "a set status".

### ***Response to Arguments***

Applicants' arguments filed 10 November 2004 have been fully considered but they are not persuasive.

Firstly, Applicants' terminal disclaimer is approved and overcomes the double patenting rejection.

Secondly, regarding claim 3, Applicants argue that the amendments meet the requirements of 35 U.S.C. §112, 1<sup>st</sup> ¶, and are supported by Page 15, Line 11 to Page 16, Line 16, of the Specification. This position is traversed.

It is maintained that the written description requirement of 35 U.S.C. §112, 1<sup>st</sup> ¶ still is not met, as there is no support as originally filed for the subject matter of amended claim 3. Page 15, Line 11 to Page 16, Line 16, of the Specification, provides a procedure when the object vocabulary of speech recognition does not include a position coordinate. A position coordinate flag PF is set in dependence on whether the vocabulary includes a position coordinate on a map. The object is to cope with the case where the recognition result is a vocabulary not including a position coordinate. However, determining whether a speech recognition result represents a point on a map is not the same as determining whether a speech recognition result includes a position coordinate. It is possible that the speech recognition result does represent a point on a map but at the same time doesn't have an associated position coordinate, as in the case where a name of a city, town, or street is spoken but is either not indexed and registered on a map database, or where the name of the city, town, or street is misrecognized. The recognition result could be a command, in which case it does not represent a point of a map, or the recognition result could be a point on a map that is not indexed or registered in a map database with an associated position coordinate.

Moreover, the Specification does not expressly provide for the limitation of "with or without the inquiry based on a set status." There is no clear disclosure as to when an inquiry is to take place and when an inquiry is not to take place depending upon

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whether the recognition result represents a point on a map or not. Page 15, Line 11 to Page 16, Line 16, of the Specification, describes position coordinate flag PF and distance decision flag DF, but does not clearly disclose under what circumstances flags determine whether a recognition result is outputted with inquiry and under what circumstances flags determine whether a recognition result is outputted without inquiry.

Thirdly, regarding the rejection of claims 1 to 3, 19, and 21 under 35 U.S.C. §103(a) as being unpatentable over *Liu et al.* in view of *Brems et al.*, Applicants point out that the present application claims priority to Japanese Patent Application P11-185859 having an effective date of 30 June 1999, which is earlier than the effective filing date for *Liu et al.* of 15 September 1999. Thus, Applicants say *Liu et al.* is not prior art.

However, Applicants cannot rely upon a priority document unless a certified translation is filed. Applicants cannot rely upon the foreign priority papers to overcome a rejection under 35 U.S.C. §103(a) because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. Applicants have priority under 35 U.S.C. §120 only until 29 June 2000. As noted by Applicants, *Liu et al.* has an earlier filing date in the United States of 15 September 1999. Applicants cannot establish priority under 35 U.S.C. §119 for a filing date in Japan until they have submitted a certified translation of the priority document. Thus, *Liu et al.* remains prior art under 35 U.S.C. §103(a).

Therefore, the rejections of claims 1 to 3, 19, and 21 under 35 U.S.C. §103(a) as being unpatentable over *Liu et al.* in view of *Brems et al.*, and of claim 3 under 35



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U.S.C. §112, 1<sup>st</sup> ¶, as failing to comply with the written description requirement, are proper.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

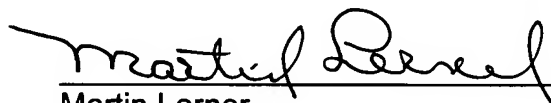
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Lerner whose telephone number is (703) 308-9064. The examiner can normally be reached on 8:30 AM to 6:00 PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (703) 305-9645. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML  
2/23/05

A handwritten signature in black ink, appearing to read "Martin Lerner", written over a horizontal line.

Martin Lerner  
Examiner  
Group Art Unit 2654